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| 09/580,583      | 05/30/2000  | Toni Kopra           | 017.38081X00        | 8331             |

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

# Office Action Summary

Application No.  
09/580,583

Applicant(s)  
Toni KOPRA

Examiner  
Stephen M. Gravini

Art Unit  
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5-20-02
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 and 7 6) ☐ Other:

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## **DETAILED ACTION**

### ***Requirements for Information***

1. 37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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2. The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicant's professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. Since the application is filed as a large entity status with Nokia as assignee, along with the fact that the inventor has many pending applications related to the claimed invention and an information disclosure statement was filed with numerous references, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination may be performed by the Office.

***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

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Non-initialed and/or non-dated alterations have been made to the oath or declaration.

Specifically the inventor post office address has been lined out but not initials accompany the alteration. See 37 CFR 1.52(c).

### *Specification*

4. The incorporation of essential material in the specification by reference to other applications is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. Specifically, the applicant has incorporated three different applications by reference, without sufficient information for a thorough examination based on the information discussed in the specification. A copy of the relevant portions of the references incorporated or amending the specification such as not to include those incorporated references, would be helpful for a thorough examination and complete application upon publication. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

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***Claim Objections***

5. Claims 17 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Both of those claims are self dependent (e.g. claim 17 depends upon claim 17 with a similar recitation for claim 18).

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-6 and 11-13 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. The independently claimed steps of providing, determining, choosing (recited as clicking), and matching does not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. Those steps can be performed by personal skills (i.e.

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watching, thinking, and selecting) such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by a human which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed method and system including the independently claimed steps of providing, determining, choosing (recited as clicking), and



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matching are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed invention specifically reciting those steps is considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps. The specification discusses this claimed concept but does not enable one skilled in the art how the independently claimed steps of providing, determining, choosing (recited as clicking), and matching is enabled, based on the specification, such that one would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed method and system including the independently claimed steps of providing, determining, choosing (recited as clicking), and matching fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of specifically reciting those features are considered

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indefinite because the specification does not provide an antecedent basis of those steps. The specification discusses this claimed concept but the claims do not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that, as discussed in the specification in light of the claims, the claims are indefinite. Claims 17 and 18 are further rejected since each of those claims depend upon themselves which is considered indefinite. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include “the steps” (claims 1 and 11), “the user” (claims 1, 7, and 11 - multiple occurrences), “the location information” (claims 1 and 11- multiple occurrences and claim 10 - single occurrence), “the Internet” (claims 2, 3, 8, 9, and 12), “the client” (claims 3, 9 - multiple occurrences and claim 18), “said steps” (claims 4, 5, and 6), “the location” and “the extracted location information” - multiple occurrences (claim 7), “the mobile terminal” (claim 11 - multiple occurrences and claim 13), “said client” (claim 14 - multiple occurrences), “the transmission” (claim 14), “the ad” (claim 15), “the bet” (claim 15), “the application server,” “the interactive,” and “the selected” (claim 16), “the selected service” (claim 17), and “the advertisement” and “the car” (claim 18). However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

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12. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

13. Claims 7-10 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). The independently claimed product placement and advertising system with separate determining, extracting, or generating means is not construed means-plus-function language under the rubric of reasonable interpretation , because the specification does not provide a clear limit of patentability. The separate determining, extracting, or generating means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-18 are rejected under 35 U.S.C. 102(a) as being anticipated by applicants' specification to each of the independently claimed inventions. Since the specification background is customarily used as an introduction to admitted prior art while the claims introduce improvements to the admitted prior art, the independently claimed invention mirrors the specification in subject matter and functionality. In this case the claims contain the same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art. Claims 1-18 are also rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tai (US 4,908,761), Walker et al. (WO 96/00950), Deaton et al. (US 5,649,114), Hyakutake (EP 0 899 950), McKeown et al. (EP 0 873 772), Feinleib (WO 98/31149), Moncrieff (US 5,828,839), Gerace (US 5,838,396), Rosin et al. (WO 99/09744), Blount et al. (GB 2 330 503), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wicks et al. (US 5,949,326), Gardenswartz et al. (US 6,055,573), Degnbol (WO 00/22860), or Tanskanen et al. (WO 01/15450).

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16. Claims 1-18 rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An internet search and a trademark database search has revealed that the claimed invention has been in public use or on sale for more than one year from the filing of the present invention. The applicant's assignee trademark of Nokia and d-box in conjunction with electronic communications has been in public use for more than one year from the filing of the present invention. That term and assignee information available on the world wide web clearly describe the claimed invention and was in use as earlier as January 1999. Since the claimed invention has been in public use or on sale for more than one year from the filing of the present application, it is statutorily barred from patenting within the United States.

17. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: the earliest release date and availability of the above mentioned trademarks by the assignee of the claimed invention.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

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***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method and system of product placement and advertising or in the alternative interactive services as provided by road side billboard advertising. The claimed advertising, advertisement, or product placement are considered non-functional descriptive material which will be discussed infra. The claimed video signal, mobile terminal, hypertext link, click(s), clicked, interactive content or provider server, or internet are considered automated features of an old and well known manual operation which will also be discussed infra. Since at least 1990, examiner has experience with the claimed invention as a viewer of road side billboard advertising. The claimed method and system comprising:

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providing an automated feature which includes a data having a further automated feature or which is accompanied by a linked data;

determining if a user of an automated device reads data;

if it has been determined that the user reads the data, providing location information of the automated feature;

determining if the location information matches stored data information; and

if it is determined that the location information matches stored advertising information, generating a location specific advertisement corresponding to the advertising information in order to forward it to an automated device; or in the alternative

an automated feature configured to receive automated data comprising data having a further automated feature and linking data;

a first determining means for determining if an automated feature user reads or chooses data and if so, recognizing data;

a means for extracting information indicating the location of the automated feature if it has been determined by said first determining means that the user read the data;

a second determining means for determining if extracted location information matches stored advertising content; and

a means for generating data corresponding to stored data content in order to forward it to the automated device if it has been determined by said second determining means that the extracted location information matches stored data content; or in the alternative

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providing an automated feature which includes a data having a further automated feature or which is accompanied by a linked data;

determining if a user of an automated device reads data;

if it has been determined that the user reads the data, providing location information of the automated feature;

determining if the location information matches stored data information; and

if it is determined that the location information matches stored advertising information, generating a location specific advertisement corresponding to the advertising information in order to forward it to an automated device; or in the alternative

a client connected to receive and respond to signals based on an automated communications channel;

an automated device connected to receive said client responses and respond to said client;

an interface for providing information pertinent to said automated data to said client;

wherein said interface can be configured by said client to display pertinent information according to preferences of said client and the automated data is tailored to transmission and reception capabilities of said client are part of examiner's personal experience. Examiner's personal experience also includes the claimed internet signal including server linking, software performance, mobile communication based on location, and ad information about a bet target including betting on a car. The claimed providing an automated feature which includes a data having a further automated feature or which is accompanied by a linked data, or an automated



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feature configured to receive automated data comprising data having a further automated feature and linking data is considered equivalent to examiner manually viewing a road side billboard containing such information as an advertisement with linked data such as directions to the subject advertisement (automation would occur in situations such as photographing or triggering a manual viewing command to the manual road side viewing). The claimed determining if a user of an automated device reads data or first determining means for determining if an automated feature user reads or chooses data and if so, recognizing data is considered equivalent to a road side billboard advertiser experiencing an increase in sales based on the road side billboard advertisement which can be easily determined by increase sales or increase traffic before and after the placement of the billboard advertisement. The claimed determination that the user reads the data, providing location information of the automated feature, determining if the location information matches stored data information, and if it is determined that the location information matches stored advertising information, generating a location specific advertisement corresponding to the advertising information in order to forward it to an automated device or second determining means for determining if extracted location information matches stored advertising content, and means for generating data corresponding to stored data content in order to forward it to the automated device if it has been determined by said second determining means that the extracted location information matches stored data content are considered equivalent to the examiner road side billboard viewer/user reading a billboard and extracting driving directions commonly displayed on the road side billboard for determining the directions to the displayed

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billboard advertisement or information (normally performed manually by reading and remembering but can be performed automatically as claimed) such that driving to the displayed billboard information is functionally equivalent to generating data and matching it to stored information. The claimed client connected to receive and respond to signals based on an automated communications channel, automated device connected to receive said client responses and respond to said client, interface for providing information pertinent to said automated data to said client wherein said interface can be configured by said client to display pertinent information according to preferences of said client and the automated data is tailored to transmission and reception capabilities of said client are considered equivalent to examiner listening to automobile radio information that is similarly displayed on viewable billboards (i.e. if examiner views a billboard advertising McDonald's food is five miles ahead at the next exit on the left then a functionally equivalent client connection would be examiner's automobile radio advertising McDonalds food services audibly displayed). The claimed internet signal including server linking, software performance, mobile communication based on location, and ad information about a bet target including betting on a car are old and well known and considered part of billboard advertising included in examiner's experience. The claimed invention has been performed by the examiner long before the filing of the present invention except for the specifically recited advertising, advertisement, or product placement. Those recitations are considered non-functional descriptive language and are not given patentable weight. It would have been obvious to those skilled in the art of the claimed method and system to use those

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recitations to seek patent protection. The non-functional descriptive language including advertising, advertisement, or product placement are considered merely information or data item necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the applicants. This non-functional descriptive language difference is only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed advertising, advertisement, or product placement would be performed the same regardless of the data or information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim a method or system particularly advertising, advertisement, or product placement, because such data or information does not functionally relate to the steps in the method and system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, the claimed invention contains automated features, such as video signal, mobile terminal, hypertext link, click(s), clicked, interactive content or provider server, or internet, which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. Video signal, mobile terminal, hypertext link, click(s), clicked, interactive content or provider server, or internet, as discussed in the specification, are interpreted to encompass automated electronic communications associated with electronic mail, Internet, and/or computer to server communications. The claimed

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invention, recited by the applicant, has been provided to examiner by personal experience long before the filing of applicant's invention. Examiner notes that it is old and well known to those skilled in the art of the claimed method and system, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed method and system since those features, particularly video signal, mobile terminal, hypertext link, click(s), clicked, interactive content or provider server, or internet, are merely automated features of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants claimed invention with the services offered by examiner's experience with road side billboard advertising is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention.

### ***Double Patenting***

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. a terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of copending Application No. 09/580,442 or over claims 1-16 of copending Application No. 09/580,443 or over claims 1-13 of copending Application No. 09/981,688. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains the an obvious variation recitation in claim language as applied to the copending application such that patentably equivalent automation devices process functionally equivalent non-functional descriptive material in the same way, using the same method or means, for the same result.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

23. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

|                    |                |
|--------------------|----------------|
| After-final        | (703) 872-9327 |
| Official           | (703) 872-9326 |
| Non-Official/Draft | (703) 872-9325 |

  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg  
May 8, 2003